UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,497	07/05/2001	Hirohisa A. Tanaka	05274.00016	8442

758 7590 01/12/2005

FENWICK & WEST LLP
SILICON VALLEY CENTER
801 CALIFORNIA STREET
MOUNTAIN VIEW, CA 94041

EXAMINER	
MCCLELLAN, JAMES S	

ART UNIT	PAPER NUMBER
3627	

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/898,497
Filing Date: July 05, 2001
Appellant(s): TANAKA ET AL.

Daniel R. Brownstone
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/29/04.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

It appears that the Amendment After submitted on May 25, 2004 was not processed until the Notice of Appeal was entered. However, the Examiner would not have entered the After Final amendment because the amendment adds new limitations ("solely") that would require additional consideration. Therefore, the After Final amendment submitted on May 25, 2004 will not be entered for this appeal.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 1-33 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

2002/0077130	OWENSBY	6-2002
6,411,891	JONES	6-2002

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

A. Claims 1, 2, 4, 6-13, 15, 17-24, 26, 28-33 rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application No. US 2002/0077130 A1 (Owensby).

B. Claims 3, 5, 14. 16. 25, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owensby in view of U.S. Patent No. 6,411,891 (Jones).

Please refer to the Final Rejection (2/27/04) for the detailed analysis of each rejection.

(11) Response to Argument

On page 3, first paragraph under **Argument**, Appellant agues that Owensby does not describe all of the limitations of the rejected claims. On page 4, second paragraph, Appellant argues in more detail that Owensby fails to disclose adjusting the billing rate "responsive to a determination that the location of the MU is inside the predetermined subsidized zone." Owensby discloses a cell phone subsidy program that determines a cell phone users geographic

location (see at least paragraph 0045) and based on the user's location offers the user a reduced cell phone billing rate if the user agrees to listen or view an advertisement (see at least paragraph 0032 on page 6). When the cell phone user agrees to listen or view the advertisement, the cell phone user will receive a reduced cell phone billing rate (see at least paragraph 0032 on page 6). According to Owensby's disclosure, a cell phone user is offered a subsidized cell phone rate in response to the geographic location of the user.

On page 4, second paragraph, Appellant attempts to overcome the Owensby reference by alleging that the current claims are limited to changing the billing rate of the user subject **only** to the location of the MU. The Examiner respectfully disagrees. The current scope of the claims does not include the term "only" or any other similar modifying term. Appellant is arguing limitations not founds in the claims. As set forth above in the section (4) of this Examiner's Answer, Appellant filed an After Final amendment on 5/25/04 that was not entered because it added new limitations that would require further consideration. In the non-entered After Final amendment (5/25/04) Appellant tried to introduce a new limitation ("solely") which is consistent with Appellant's current argument. However, as clearly stated by Appellant on page 2 of his Appeal Brief, the After Final amendment (5/25/04) was not entered. Therefore, Appellant's attempt to add the term "solely" to the claims is a clear indication that Appellant realized that the current scope of the claim is anticipated by the system and method disclosed by Owensby.

On page 4, second paragraph, Appellant provides an example based on the disclosure of Owensby, wherein User A and User B both make a call from the same location to the same telephone number. Appellant' example states that User A, who receives advertisements, will receive a lower rate than User B, who declines the ads. Appellant is admitting that User A

anticipates his claims. The fact that User B in Appellant's example may not anticipate the current claims does not preclude the fact that User A does anticipate the claims. Since Appellant failed to limit the claims to a user receiving a cell phone subsidy for "only" or "solely" being located in a predetermined geographic, Owensby clearly anticipates the claims. As set forth above, in Appellant's non-entered After Final amendment, Appellant acknowledges the need for the term "solely" to overcome the reference. However, Appellant is currently attempting the overcome Owensby using that argument even though the limitation is not found in the claim.

On page 5, second paragraph, Appellant argues that it is improper to combine Owensby and Jones because they are non-analogous art. The Examiner respectfully disagrees. Jones is relied upon merely to teach the fact that location detection systems other than GPS are old and well known in the art. Since both Owensby and Jones are related to determining the physical location of a subject, the two references are analogous when their combination is based on that common thread. Jones' teaching of various types of geographic location systems is clearly analogous to Owensby's device which utilizes a geographic location system.

In conclusion, Appellant attempts to overcome a solid 35 U.S.C. § 102 rejection based on Owensby by arguing limitations not found in the claims. Owensby provides users with reduced cell phone rates based on their geographic location. Appellant argued that Owensby fails to provide reduced cell phone rates based "solely" or "only" on their geographic locations. However, neither "solely" nor "only" are limitations found in the claims.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

James S. McClellan

James S McClellan
Primary Examiner
Art Unit 3627

jsm
January 7, 2005

Conferees
J. Thomas
R. Zeender

FENWICK & WEST LLP
SILICON VALLEY CENTER
801 CALIFORNIA STREET
MOUNTAIN VIEW, CA 94041